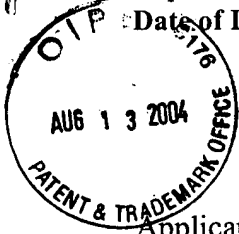


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Date of Deposit: August 12, 2004

Docket No.: 0503-002US3



08/16/04 2626 30

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Frederick J. Murphy	Examiner:	Rogers
Serial No:	09/877,239	Art Unit:	2626
Filed:	June 11, 2001		
Title:	Method and Apparatus for Delivery of Facsimile Documents over a Computer Network		

Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

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Technology Center 2600

**CONDITIONAL REQUEST TO WITHDRAW UNDER**

**37 CFR 1.36, 37 CFR 10.40, and 37 CFR 10.170**

The undersigned attorney respectfully submits this conditional request to withdraw ("Request"), and asks that it be held in abeyance pending further proceedings of the U.S. Bankruptcy Court of the District of Maryland (Baltimore), including a decision to a Motion to Lift Stay that was filed with the Bankruptcy Court on August 10, 2004, as more fully explained below. This Request is being filed in response to a demand made by the Chapter 7 Bankruptcy Trustee for NetFax Incorporated, who claims that authorization from the bankruptcy court is needed prior to any further action by inventor/applicant before the Office. While applicant/inventor respectfully disagrees, the undersigned files this Request to Withdraw as a conditional request, in order to also meet applicant/inventor's duty of disclosure by informing the Office of this development. 37 CFR 1.56; 37 CFR 10.38(b), 10.68, and 10.84.

For the convenience of the Office, this Request to Withdraw is accompanied by the following exhibits:

- Exhibit A: Letter of August 4, 2004, from Ms. Meyer-Leon to prior representative Mr. Peterson, with Revocation and Power of Attorney forms
- Exhibit B: Letter of August 4, 2004 from Mr. Summers, on behalf of Bankruptcy Trustee, to Ms. Meyer-Leon
- Exhibit C: Letter of August 6, 2004, from Ms. Meyer-Leon to Mr. Summers
- Exhibit D: Motion to Lift Stay (without exhibits)
- Exhibit E: Exhibit B to Motion to Lift Stay: Petition under 37 CFR 1.181(A) And 37 CFR 3.73(b) for Declaration as to Type of Application

#### BACKGROUND

1. On information and belief, patent application U.S. Serial No. 08/555,911 was filed on November 13, 1995, naming Frederick J. Murphy as sole inventor (the "Original Application"), and is pending.

2. On information and belief, patent application U.S. Serial No. 09/184,972 ("the '972 application") was filed on November 3, 1998, as a divisional application of the Original Application. The '972 application issued as U.S. Patent Number 6,028,679 on February 22, 2000.

3. On information and belief, patent application U.S. Serial No. 09/506,925 ("the '925 application") was filed as a divisional application of the '972 application on February 18, 2000.

4. On information and belief, the above-captioned application ("the '239 application") was published on March 21, 2002, as US Published Application US 2002/0033961A1. The

'related application data' shown on the first page of the published application indicates that the '239 application claims benefit from the '925 application as a divisional application.

5. On information and belief, an assignment has been recorded at reel/frame 008316/0076 in the USPTO Assignment Division, and given an effective recordation date of November 4, 1996. According to a copy of this assignment document obtained from the public records of the Assignment Division, this document appears on its face to be a conveyance of title to the Original application from Mr. Murphy to NetFax Incorporated ("Debtor") and divisionals and continuations thereof, but does not extend to continuation-in-part applications.

6. On information and belief, Mr. Murphy has never assigned any of his right, title and interest under the '239 application, and, in the event the '239 application is confirmed to be a CIP, Mr. Murphy retains the right to take action in the '239 application. *See*, 37 C.F.R. § 3.73(a) ("The inventor is presumed to be the owner of a patent application, and any patent that may issue therefrom, unless there is an assignment.").

7. On May 14, 2002, NetFax Incorporated (hereafter "Debtor") filed a voluntary petition for relief under Chapter 11 of the United States Bankruptcy Code, in the United States Bankruptcy Court for the District of Maryland (the "Bankruptcy Court"), Case Number 02-5777-SD. On or about June 21, 2002, the Bankruptcy Court converted the case to a Chapter 7 proceeding. *In re: NetFax, Inc., Bankruptcy Case No. 02-5777-SD (Chapter 7), In the United States Bankruptcy Court for the District of Maryland* (hereafter "Bankruptcy Proceeding").

8. On or about April 6, 2004, Mr. Joseph Bellinger, the Chapter 7 trustee for the Debtor's estate (hereafter "Bankruptcy Trustee") filed his *Motion for Authority to Sell the Bankruptcy Estate's Interest in Intellectual Property Subject to Pre-Petition Secured Claims and Free and*

*Clear of Post-Petition Secured Claims* (the "Motion to Sell"), pursuant to which the Trustee requested that the Bankruptcy Court authorize him to sell certain intellectual property, including the '239 application, to an identified prospective bidder or such party that makes a higher and better offer to purchase the property. As of the date of this Request, a hearing for the sale of the Debtor's intellectual property, including allegedly the '239 application, has been scheduled for August 20, 2004. *Second Amended Notice of hearing on Chapter 7 Trustee's Motion for Authority to Sell the Bankruptcy Estate's Interest In Intellectual Property Subject to Pre-Petition Secured Claims and Free and Clear of Post-Petition Secured Claims*, July 7, 2004.

9. The undersigned was recently engaged by Mr. Murphy and, acting on behalf of inventor Murphy, downloaded a copy of the published patent application corresponding to the '239 application, US 2002/0033961A1, published March 21 2002, along with a copy of US 6,028,679, from Delphion®, a commercial provider of published patent documents. The 'Related US Application Data' on the first page of US 2002/0033961A1, stated that the '239 application is a "Division of application No. 09/506,925, filed on Feb. 18, 2000, which is a division of application No. 09/184,972, filed on Nov. 3, 1998, now Pat. No. 6,028,679, which is a division of application No. 08/555,911, filed on Nov. 13, 1995." US 2002/0033961A1, March 21 2002, page 1. Although the benefit claims of the '239 application were described as an unbroken chain of divisional filings, the '239 application was observed to have a substantial amount of added subject matter relative to US 6,028,679, suggesting that the benefit chain needs to be corrected to reflect the filing of a CIP application within the chain. *See*, MPEP § 201.08.

10. The undersigned, on behalf of inventor Murphy, has received a copy of the prosecution file wrapper for the '925 application that had been copied from the public records of

the Office by a commercial document service. The file wrapper included copies of the transmittal papers, specification, and drawings of the '925 application, allegedly as filed on February 18, 2000. Although the '239 application has forty-seven figure drawings, the immediately preceding application, the '925 application, has only nine figure drawings, which appeared incompatible with the fact that the '239 application had been designated to be a divisional application of the '925 application.

11. Although the Bankruptcy Trustee has claimed that the '239 application is property of the Debtor's estate, inventor Murphy is of the view that, as a CIP application, title to the '239 application is not held by the Debtor's estate. While a prior assignment recorded against an original application is applied to a divisional, it is not applied to a CIP, which requires a new assignment. No new assignment has been executed for the '239 application, so Mr. Murphy continues to hold title to the '239 application.

12. A *"Revocation Of Power Of Attorney With New Power Of Attorney And Change Of Correspondence Address"* (PTO/SB/82 09-03) form was executed on July 26, 2004, by Mr. Murphy as inventor applicant, filed with the Office by express mail on July 29, 2004, and received by the Office on July 30, 2004 (hereafter *"Revocation and Power of Attorney"*). The *Revocation and Power of Attorney* revoked all previous powers of attorney given in the '239 application, and appointed power of attorney to the undersigned. On August 4, 2004, prior representative Thomas Peterson was provided with a copy of the *Revocation and Power of Attorney*, accompanied by a cover letter from the undersigned, a copy of which is attached hereto as Exhibit A.

13. On August 4, 2004, Mr. Matthew Summers, an associate attorney working on behalf of the Bankruptcy Trustee, sent a letter to the undersigned alleging that the Revocation and Power of Attorney violated the automatic stay in the Bankruptcy Proceeding. Exhibit B. On August 6, 2004, the undersigned responded to the Bankruptcy Trustee, denying that the act of filing a Revocation and Power of Attorney violated the automatic stay but agreeing, in the interest of moving toward a determination of title to the '239 application without the distraction of extraneous issues, to file, without prejudice, a request to withdraw as attorney under 37 CFR Part 10. Exhibit C.

14. As explained herein, Inventor Murphy has had and continues to have a reasonable and good faith basis for believing that the '239 application is in fact a CIP application rather than a divisional filing, and that the '239 application has not been assigned to the Debtor and is not property of the Debtor estate. With this good faith basis, inventor Murphy's filing of a Revocation and Power of Attorney did not violate the automatic stay.

15. Notwithstanding that good faith belief, in order to address the Bankruptcy Trustee's allegations, inventor Murphy on August 10, 2004, filed a motion with the Bankruptcy Court, requesting a lift of the automatic stay for the limited purpose of seeking the Bankruptcy Court's authorization to file a petition with the patent office for a determination as to whether the '239 application is a "divisional application" (as stated on the face of the corresponding published application) or a CIP application (based on the additional subject matter included in the '239 application but not found in the prior '925 application), and to take all actions necessary to effectuate and facilitate the filing of the petition (including filing a new power of attorney).

*Motion of Frederick J. Murphy for Relief From the Automatic Stay, August 10, 2004 (hereafter*

“Motion to Lift Stay”). A copy of the Motion to Lift Stay is attached hereto as Exhibit D, and a copy of the proposed petition (Exhibit B to the Motion to Lift Stay), is attached hereto as Exhibit E.

REMARKS

It is respectfully submitted that applicant/inventor Murphy has filed a Revocation of Power of Attorney in this case, having the reasonable and good faith belief that as inventor he retains the title of the ‘239 application that is initially vested in the inventor, and thus retains the right to take action in the instant application. The undersigned appreciates the importance of complying with all applicable bankruptcy law and with the authority of the Bankruptcy Court, and therefore, in deference to the allegation of the Bankruptcy Trustee that Mr. Murphy’s actions in the patent office are an alleged violation of the bankruptcy stay (which allegation is respectfully disputed), files this Request to Withdraw. The undersigned has also set forth the factual background of this matter and, as a member of the patent bar and aware of the obligations of disclosure and candor to the U.S. Patent Office, wishes to fully inform the Office of the present situation. 37 CFR 1.56; 37 CFR 10.38(b), 10.68, and 10.84.

Should the Office consider submission of the present request proper, it is respectfully requested that the Office hold the present Conditional Request to Withdraw in abeyance pending further proceedings in the Bankruptcy Court, including while the Motion to Lift Stay is pending, so that the status of the ‘239 application is not endangered by lack of a proper correspondent to receive Office communications. *See*, 37 CFR 1.33. In making this request, applicant/inventor Murphy submits that he does not wish to place prior representative Peterson in a position of

conflict of interest pursuant to 37 CFR 10.66, and is thus reluctant to reappoint power of attorney to Mr. Peterson. Thus, it is respectfully requested that action on the Request to Withdraw be suspended until such time as the Bankruptcy Court takes further action.

CONCLUSION

Please charge any outstanding fees, or credit any overpayments, to Deposit Account No. 50-1895, Ref. No. 0503-002US3.

Respectfully submitted:

Date:

Aug 12, 2004

Leslie Meyer-Leon

Leslie Meyer-Leon  
Reg. No. 37,381

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Enclosures: Exhibits A-E, Postcard